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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ronald E. Sloan

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10/02/2007

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MINNEAPOLIS, MN 55402-1609

EXAMINER

GREIMEL, JOCELYN

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

10/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/927,560

Applicant(s)

SLOAN ET AL.

Examiner

Jocelyn Greimel

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10,12-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-18,20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 July 2007 has been entered.

#### ***Status of Claims***

Claims 1, 3-10, 12-18 and 20-25 are currently pending. Claim 1, 9 and 18 are independent claims.

#### ***Response to Arguments***

Applicant's arguments filed 27 July 2007 have been fully considered but they are not persuasive. Applicant's arguments involve the pricing and set-up of the service agreement. Applicant's arguments lie generally within the "wherein" clauses of the independent claims. Please see the claim objections below. The combination of Jones, Wren and Killeen do disclose a method, system and apparatus for on-line, web-based financial counseling over the Internet as described by Applicant's claims.

### ***Claim Objections***

Claims 1, 3-10, 12-18 and 20-25 are objected to as containing non-functional language, which does not further limit the claims. MPEP §2111.04 states: Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C) "whereby" clauses.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 3-10, 12-18 and 20-25 are rejected under 35 U.S.C. 103(a) as being obvious over Jones (US Patent No. 6,021,397) in view of Wren (US Patent No. 6,055,514)**

**and further in view of Killeen (US Patent No. 6,324,523).** In reference to claims 1, 6-8, 9, 14-17, 18 and 20-25, Jones discloses a method, system, apparatus and computer readable medium for providing online web-based financial counseling over a wide area network such as the Internet, comprising:

aa. providing a plurality of unique service levels each including a combination of computer coaching and live coaching, wherein each of the unique service levels includes a unique combination of amounts of available coaching and live coaching;

a. developing a service level agreement with a user which includes a desired service level wherein developing a service level agreement comprises:

i. prompting the user to input personal financial information;

ii. receiving from the user a desired service level selected from the plurality of available unique service levels;

iii. estimating profitability based on the financial information; and iv. negotiating fees to be charged to the user based upon estimating profitability and the desired level of service prior to providing services under the service agreement;

b. developing a financial model for the user utilizing computer coaching and live coaching wherein the coaching includes permitting the user to enter a dialogue with at least one of a computer-generated coach and a live-coach over the Internet as determined by the service level agreement; and

c. using the financial model utilizing said computer coaching and said live coaching as determined by said service level.

3. Jones fails to teach developing a financial model for the user utilizing at least one of computer coaching and live coaching as determined by the service level agreement; and using the financial model remotely utilizing at least one of said computer coaching and said live coaching as determined by said service level agreement. Wren discloses developing a financial model for the user utilizing at least one of computer coaching and live coaching as determined by the service level agreement; and using the financial model remotely utilizing at least one of said computer coaching and said live coaching as determined by said service level agreement (col. 9, line 2 - col. 17, line 29). It would have been obvious to one having ordinary skill in the art at the time of the invention for Jones' computerized financial model system to use a live coach as disclosed by Wren as the live interaction would aid in customer service and improve the interaction and financial preparation between the financial corporation and the client.

4. Jones and Wren do not disclose a selection of a desired service level from a plurality of available service levels. However, Killeen discloses selecting an amount of coaching advice and a selection of a type of financial product configuration, which is a selection of service level (see at least table 1: "service entitlement summary"). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have modified the financial modeling system with various types of coaching, as in Jones and Wren, with the ability to select a service level from a variety of service levels as in Killeen as it would create a more user-oriented service as the user can

select exactly what type of system they need, thereby increasing system use and provider profitability.

5. Additionally, in reference to claims 3, 4, 5, 10, Jones discloses a financial counseling system wherein:

- a. The service level agreement includes a determination of access to at least one account of a user (col. 3, line 30 - col. 4, line 59; col. 5, line 50 - col. 6, line 2; col. 6, line 3 - col. 7, line 10);
- b. The financial model includes developing a user's equity investment portfolio (col. 3, line 30 - col. 4, line 59; col. 5, line 50 - col. 6, line 2; col. 6, line 3 - col. 7, line 10);
- c. Determining the financial goals of the user and the user's risk tolerance, determining the current equity positions of a user, and suggesting new equity positions for a user (col. 3, line 30 - col. 4, line 59; col. 5, line 50 - col. 6, line 2; col. 6, line 3 - col. 7, line 10);
- d. The wide area network is the Internet (col. 7, lines 50-60).

### ***Conclusion***

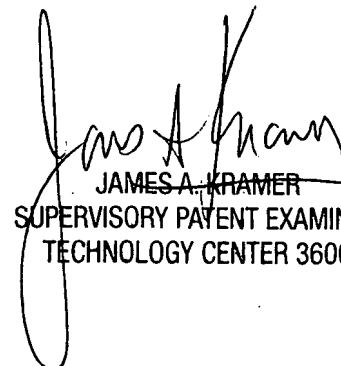
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel  
Examiner, Art Unit 3693  
September 24, 2007

  
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9-25-07